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Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run \_\_\_\_\_ or continues to run 3 mons from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 6/18/01 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
  - b. ☐ They raise new issues that would require further consideration and/or search. (See Note)
  - c. ☐ They raise the issue of new matter. (See Note).
  - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims

NOTE: \_\_\_\_\_

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☒ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: 19-23 and 26-35

Claims objected to: none

Claims rejected: 2, 3, 17, 18, and 36

However,

☒ Applicant's response has overcome the following rejection(s) Scope of amendment neg.

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because of reasons of record and more fully responded to as attached.

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner

☐ Other

09/076,404

Further Explanation of Item 4 on the attached Advisory Action:

The NEW MATTER objection to the specification is maintained regarding the specific citation of the software packages on page 94 of the specification. Applicants argue that the Declaration of Dr. Ecker supports the amendment on said page 94. In response the Declaration does not indicate that the software packages are inherently "only" those corresponding to the citations on said page 94. In fact, the software entitled "Insight II" is significantly suggestive that there is actually another version I. It is also noted that what is implied or suggested as filed does not rise to the level of written description. See, for example, the legal decisions of *In re Winkhaus, Tusche, and Kampf* (188 USPQ 129) and *In re Symthe and Shamos* (178 USPQ 279).

The discussion of the various software packages, however, is persuasive that the scope of enablement rejection against the claims is hereby withdrawn.

The rejection under 35 U.S.C. § 102(a) based on Chen et al. is maintained regarding claims 2, 3, 17, 18, and 36 (necessitated by amendment). The rejected claims are not limited to single stranded target RNAs and thus are inclusive of the double-stranded versions of Chen et al. Applicants then argue that the major groove sections of Chen et al. are not independently folded. In response this is non-persuasive in that there is no distinguishing definition of independently folded that separates the RNA section analysis of Chen et al. from the instant

invention. Also, the analyzed section of Chen et al. is no more or less independently folded than a section of RNA as instantly analyzed. Lastly, applicants argue that no interaction site is taught by Chen et al. In response the major groove of Chen et al. is reasonably an interaction site in contrast to applicants' arguments which do not define an interaction site to distinguish it as instantly claimed over such a site in Chen et al.

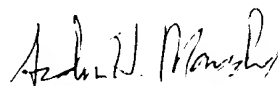
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Flunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

June 28, 2001

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER